

## REMARKS

### I. Introduction

In response to the Office Action dated January 12, 2006, Applicant has amended claims 22-23, 34-35 and 38 so as to further clarify the claimed subject matter. Support for these amendments can be found, for example, at page 13, lines 2-5 of the specification. No new matter has been added.

For the reasons set forth below, Applicant respectfully submits that all pending claims are patentable over the cited prior art references.

### II. The Rejection Of Claims 23, 34 and 38 Under 35 U.S.C. § 112, Second Paragraph

Claims 23, 34 and 38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, because these claims contain a trademark/trade name.

In an effort to advance prosecution, these claims have been amended solely to overcome the alleged indefiniteness and are submitted to now be definite. Particularly, these claims have been amended to recite “[Elvax® resin]] copolymers of polyethylene, polypropylene, polybutene, polyethylene oxide or polypropylene oxide”.

Accordingly, in view of the foregoing amendments, Applicant respectfully requests that the rejection of claims 23, 34 and 38 under 35 U.S.C. § 112, second paragraph, be withdrawn.

### III. The Rejection Of Claims 22-31 Under 35 U.S.C. § 102(b)

Claims 22-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by USP No. 6,226,890 to Borocon. Applicant respectfully traverses this rejection for at least the following reasons.

Claim 22, as amended, recites in-part an inert material disposed in the encapsulated device, where the inert material is adapted to respond to energy input either by melting or morphological change.

In the statement of rejection, the Examiner reads the binder 52 contained in the desiccant layer 50 of Borocon as the claimed inert material. However, as is evident, Borocon expressly teaches away from the claimed invention by heating and curing the desiccant layer 50 including the binder 52 to a solid under controlled conditions so as to remove residual solvents (see, col. 6,

lines 59-62). That is, the desiccant layer 50 of Boroson is cured by heating, and therefore is not exposed to melting or morphological change.

Accordingly, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Boroson fails to teach the foregoing claimed feature, it is clear that Boroson does not anticipate claim 22 or any of the claims dependent thereon.

**IV. The Rejection Of Claims 35, 36 and 38 Under 35 U.S.C. § 102(e)**

Claims 35, 36 and 38 are rejected under 35 U.S.C. § 102(e) as being anticipated by USP No. 6,737,176 to Otsuki. Applicant respectfully traverses this rejection for at least the following reasons.

Claim 35, as amended, recites in-part a first layer of reactive material, and a second layer of an inert material disposed on the first layer where the inert material is adapted to respond to energy input either by melting or morphological change.

In the statement of rejection, the Examiner reads the resin layer (adhesive 60) included in the desiccating layer 62 as the claimed inert material. However, similar to the deficiencies discussed above with respect to Boroson, Otsuki expressly discloses that the resin layer is a photo-curable resin (i.e., cured by heating, col. 6, lines 33-35). That is, the resin layer of Otsuki is cured by energy input, and is not exposed to melting or morphological change.

Accordingly, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Otsuki fails to teach the foregoing claimed feature, it is clear that Otsuki does not anticipate claim 35 or any of the claims dependent thereon.

**V. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable**

Under Federal Circuit guidelines, a dependent claim is neither anticipated nor rendered obvious if the independent claim upon which it depends is allowable because all the limitations

of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 22 and 35 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

**VI. Conclusion**

By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

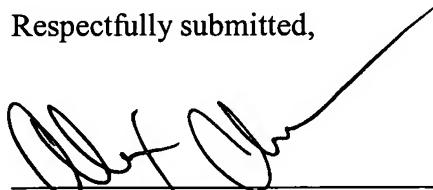
For all of the reasons set forth above, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 06-1050 and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: 3/30/06

  
\_\_\_\_\_  
Alex H. Chan  
Reg. No. 52,713

Fish & Richardson P.C.  
500 Arguello Street, Suite 500  
Redwood City, California 94063  
Telephone: (650) 839-5070  
Facsimile: (650) 839-5071